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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,747	11/13/2000	Richard L. Spagna	SOM920000016US1	8049

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,747

Applicant(s)

SPAGNA ET AL.

Examiner

CUONG H. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This Office Action is answer to the election of claims 1-16 without traverse (claims 9-16 have been amended to fall in Group I (claims 1-8), received on 5/21/2004 from Mr. Jon A. Gibbons (Reg. No. 37,333) which paper has been placed of record.

2. Claims 1-16 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipate by Stefik (US Pat. 5,715,403).

This claim is merely and broadly directed to an authorization to make an extra copy of digital content after receiving a request, reviewing usage conditions, and authorize to make copies.

Stefik suggests a method on an end user system for updating previously stored usage conditions (see Stefik, the abstract for usage rights) to allow additional copies of previously received encrypted digital content to be made on a computer readable medium (see Stefik, 45:4-9), comprising:

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- receiving a request from a user/"Repository 2" to create a copy of previously received encrypted digital content with associated usage conditions (see Stefik, Fig.1, ref. 104);
- reviewing the associated usage conditions to determine if said additional copy has been authorized (see Stefik, Fig.1, ref. 105); and then
- transmitting said digital work to Repository 2 - in another word, creating said copy onto a computer-readable medium (see Stefik, Fig.1, ref. 107).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-16 are is rejected under 35 U.S.C. 103(a) as being unpatentable over **Stefik (US Pat. 5,715,403)**, in view of Yoshiura et al. (US Pat. 6,131,162).

The rationales and reference for rejection of claim 1 are incorporated.

a. Per claims 2, 7, 10: Stefik obviously suggests about sending a request over a telecommunications infrastructure from the end user system to an electronic store for the permission to create additional copy of the previously received encrypted digital content (see Stefik, 45:4-9).

Stefik does not disclose about: receiving from the electronic store a description of the previously received encrypted digital content requested to be copied with an associated hash value; and comparing the hash value received with a previously stored hash value to determine if they are identical and if the hash value is not identical not authorizing additional copy to be made.

However, Yoshiura et al. suggest those actions (see Yoshiura et al., 2:11-19, Fig.9 ref. 1101-1, Fig.4 ref. S402; Fig. 24, refs. 2408, 2409, 2404, and 2:45-50, 14:12-20).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Stefik and Yoshiura et al. in comparing a first hash value and a second hash value for authorizing to make an additional copy of a digital content product because Yoshiura et al. suggest about a comparison of 2 different hash values sending at 2 different times to a user; this increases a level of verification to prevent unauthorized copying of digital contents.

b. Per independent claim 15: It is directed to a computer program product to perform the method of claim 1; therefore, an obviousness rejection based on 35 USC 103(a) (using Stefik and Yoshiura et al.) is also applied to claim 15.

c. Per independent claim 9: It is directed to a computer

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program product to perform the method of claim 1 (see Yoshiura et al., 9:47-49, and 8:24-25); therefore, an obviousness rejection as in claim 2 is also applied to claim 15.

d. Per dependent claims 3, 11: Yoshiura et al. also suggest to creating an additional copy includes by decrypting the previously received encrypted digital content in a tamper resistant environment (see Yoshiura et al., Fig.5 and 1:50-53).

e. Per dependent claims 4, 12: Yoshiura et al. also suggest a step of creating an additional copy on a computer readable medium selected from computer readable mediums such as recordable CDs, DVDs, Zip Disks, tape, Flash memory, and RAM (see Yoshiura et al., 33:4-9).

f. Per dependent claims 5, 13: Yoshiura et al. also suggest a step of receiving encrypted digital content if the additional copy has not been authorized (see Yoshiura et al., Fig.4 ref. S402).

g. Per dependent claims 6, 14: The rationales and references for rejection of claim 2 are incorporated.

Stefik also suggests of sending payment information from a user system to an electronic store for payment of any additional copy of the previously received encrypted content (See Stefik, Fig.3 and 8:21-29).

h. Per dependent claims 8, 16: The rationales and references for

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rejection of claim 10 are incorporated.

Yoshiura et al. also suggest a step of creating an additional copy of an encrypted content onto a computer readable medium by decrypting the encrypted digital content in a tamper resistant environment (see Yoshiura et al., 1:47-55).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Stefik and Yoshiura et al. in comparing a first hash value and a second hash value for authorizing to make an additional copy of a digital content product because Yoshiura et al. suggest about a comparison of 2 different hash values sending at 2 different times to a user; this increases a level of verification to prevent unauthorized copying of digital contents.

Conclusion

5. Claims 1-16 are not patentable.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is

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703-305-7687/703-746-5572.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuong H. Nguyen

CHN
CUONG H. NGUYEN
Primary Examiner
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